

REMARKS

The Office Action has maintained the Restriction Requirement earlier imposed. It has restricted the subject matter in the present application to compounds or compositions of Formula Ia, recited in Claims 22 and 26-32. The Office Action has objected to the title, alleging that it is not descriptive. The Office Action has further objected to the Abstract. In addition, the Office Action has objected to Claims 22 and 26-29 and has rejected Claims 30-32. More specifically, the Office Action has objected to Claims 26-32 for containing non-elected subject matter and for allegedly being in improper form. It has also objected to Claims 30-32 under 35 U.S.C. §112, first paragraph, for allegedly being non-enabling. The Office Action has further objected to Claims 30-32 under 35 U.S.C. §112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Further, it has rejected Claims 30-32 under 35 U.S.C. §102(b) as defining subject matter which is allegedly anticipated by the teachings in Lauenstein et al. in Biochemica et Biophysica Acta, 1956, 21, 587-8 ("Lauenstein"). Further Claims 30-32 are rejected under 35 U.S.C. §102(b) as defining subject matter which is allegedly anticipated by the teachings in Iyer et al. in the Journal Scientific & Industrial Research, 1956, 15C, 1-7 ("Iyer et al."). Finally, Claims 30-32 are rejected under 35 U.S.C. §102(b) as defining subject matter which allegedly anticipated by the teachings in Nowak et al. in the Journal Arzneimittel-Forschung, 1966, 16(3), 407-11 ("Nowak et al"). Finally, Claims 30-32 are provisionally rejected on the grounds of non-statutory obviousness-type double patenting for being allegedly unpatentable over Claim 1 of U.S. Patent Publication No. 2008/0119470.

Applicants have amended the claims, which when considered with the comments

hereinbelow, are deemed to place the present case in condition for allowance. Favorable action is respectfully requested.

Applicants have amended Claim 22 to be consistent with the election of the restriction requirement comprised of Formula Ia. Applicants have not abandoned the non-elected subject matter and reserve the right to file a divisional application directed thereto.

Claim 22, as originally filed, was dependent on Claims 1-9. Accordingly, when the present application was restricted to compounds of Formula Ia, which is subgeneric to compounds of Formula I, applicants incorporated the subject matter of original Claim 1 into Claim 22, as it applies to compounds of Formula Ia. Thus, applicants incorporated original proviso (iii) of Claim 1 into Claim 22. Claim 22 further recites that either position 5 or 7 of the ring is halo. Support for this subject matter in Claim 22 is found on Page 11, Line 16 to Page 12, Line 16 and Page 34, Line 10 to Page 35, Line 35 of the instant specification.

Claim 26 has been amended to be consistent with the election for restriction requirement. Claims 29-31 were cancelled as they include subject matter that is not consistent with the election. Claims 35-43 have been added to the application. Claim 35 is supported by the subject matter in original Claim 5. Support for Claim 36 is found in original Claim 6. Claim 37, incorporates the subject matter of original Claim 7. The subject matter of Claims 38, 39, 41, 42 and 43 is supported by the disclosure on Page 11, Line 16 to Page 12, Line 16 of the instant specification. Claim 40 incorporates the subject matter of original Claim 32.

No new matter is added to the application.

In the amendment to the claims, as discussed above, applicants have removed non-elected subject matter from the claims. In addition, applicants have removed all multiple dependences from the claimed subject matter. Moreover, the subject matter in the claims is

directed to either a compound or a pharmaceutical composition, i.e., the claims recite the subject matter therein in the singular. Accordingly, the objection to Claims 22 and 26-32 is obviated; withdrawal thereof is respectfully requested.

Applicants have renamed the title and have rewritten the Abstract. Further, applicants have reviewed the specification, but did not find any errors therein. Withdrawal to the objections to the specification is respectfully requested.

Pursuant to the rejection of Claims 30-32 under 35 U.S.C. §112, first paragraph, the Office Action alleges that the application is enabled for a compound, a composition, pharmaceutically acceptable salts or the tautomers. The Office Action alleges that the specification does not provide enablement for hydrates, solvates, derivatives, prodrugs and/or isomers, or the compounds, composition, salts or tautomers wherein R^1 , R^2 or R^3 is an anti-oxidant or a targeting moiety. The Office Action also alleges that the application is not enabling for the treatment of diseases for the hydrates, solvates, derivatives, prodrugs and/or isomers, or the compounds composition, salt, or tautomers where R^1 , R^2 or R^3 is an anti-oxidant or targeting moiety. Although applicants disagree, applicants have deleted this subject matter from the claims. Applicants have not abandoned this subject matter, and reserve the right to file the same in a continuation application.

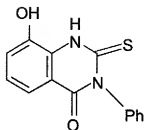
As a result, the rejection of Claims 30-32 under 35 U.S.C. §112 is obviated; withdrawal thereof is respectfully requested.

Pursuant to the rejection of Claims 30-32 under 35 U.S.C. §112, second paragraph, the Office Action alleges that the term "aryl", "cycloalkyl", "heterocyclyl" and "optionally substituted" are vague and ambiguous. The claims, as amended, have defined these terms with greater specificity. As amended, the subject matter therein is clearly understood by

one skilled in the art, and the metes and bounds of the claims are clearly delineated.

Consequently, it is respectfully submitted that this rejection is overcome; withdrawal thereof is respectfully requested.

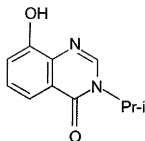
Pursuant to the rejection of Claims 30-32 under 35 U.S.C. §102(a), the Office Action cites Lauenstein et al. According to the Office Action, Lauenstein et al. disclose the following compound:



According to the Office Action, this is a tautomer of a compound of Formula Ia wherein RH is OH, q = 2, and R¹ is SR² and R² is hydrogen and the second R¹ is a phenyl ring. As amended, the claimed subject matter excludes compounds wherein R¹ is SR² and R² is hydrogen. As amended, one of R¹ is SR⁴ and R⁴ does not include hydrogen in its definition, so that the above compound cannot be a tautomer of the claimed compounds. Moreover, unlike the compounds of the present invention which requires a halo substituent at position 5 or 7, the compound referred to by the Office Action in Lauenstein et al. do not contain a halo substituent. Accordingly, Lauenstein et al. do not teach or disclose the claimed subject matter, i.e., there are differences between the claimed subject matter and the compound described in Lauenstein et al. and discussed in Paragraph 17 of the Office Action. Accordingly, Lauenstein et al. do not anticipate the claimed subject matter. Withdrawal of this rejection is respectfully requested.

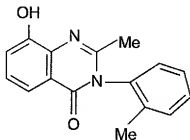
Pursuant to the rejection of Claims 30-32 under 35 U.S.C. §102, the Office Action

cites Iyer et al. According to the Office Action, Iyer et al. disclose a compound of the formula



which, according to the Office Action, is a compound of Formula Ia where RH is OH and $q = 1$ and R^1 is an isopropyl group. However, there are several differences between the compounds of Formula Ia and the above compound. For example, as indicated hereinabove, the compound of Formula Ia has a halo group on position 5 or 7 of the ring. The above compound has no halo group at the 5 or 7 position of the ring. In fact, this compound does not have a halo group at any position on the ring. Accordingly, this rejection of Claims 30-32 under 35 U.S.C. §102(b) is obviated; withdrawal thereof is respectfully requested.

Pursuant to the rejection of Claims 30-32 under 35 U.S.C. §102(b), the Office Action cites Nowak et al. According to the Office Action, Nowak et al. disclose a compound of the formula:



The Office Action alleges that this is a compound of Formula 1 where RH is OH, $q = 2$, wherein one R^1 is a methyl group and the second R^1 is an O-tolyl group.

It is respectfully submitted that Nowak et al do not disclose or teach the present

invention. More specifically, it does not teach a quinoxaline having an 8-hydroxy substituent. Although Nowak et al. discuss hydroxylation of MTQ, which is a 2, 3-disubstituted quinoxaline, without a hydroxy group at the 8-position, it is respectfully submitted that MTQ will not undergo hydroxylation at the 8-position to produce the compounds of the present invention. Reference is made to the reaction scheme at Page 110.

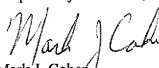
However, even assuming, pro arguendo, that the 8-hydroxy compounds of the present invention are disclosed in Nowak et al, it is respectfully submitted that there are still several differences between the present invention and the subject matter described in Nowak et al. For example, the compounds in Nowak et al. do not contain any halo group – let alone a halo group at position 5 or 7 of the ring. Thus, Nowak et al. do not teach, or disclose the claimed subject matter. Accordingly, Nowak et al. do not anticipate the claimed subject matter. Thus, this rejection is obviated; withdrawal thereof is respectfully requested.

In response to the non-statutory double patenting rejection over Claim 1 of U.S. Patent Publication No. 2008/0119470, applicants respectfully submit that it is too premature to reject the claims in this application on double patenting grounds. The '470 publication has been filed later than the present application. During prosecution of the '470, publication, Claim 1 may be amended to the extent that the subject matter therein is patentably distinct from the subject matter in the present application. Moreover, it is respectfully submitted that the amendment to the claims overcome the other rejections raised in the Office Action. According to MPEP §804IB1, if a provisional non-statutory obvious-type double patenting rejection is the only rejection remaining in the earlier filed of two pending applications, the Examiner should withdraw that rejection and permit the earlier filed application to issue without a terminal disclaimer. Since the filing date of the present application is earlier than the filing date of that of

the '470 publication and since this Response overcomes the other rejections imposed, in accordance with MPEP §804IB1, the United States Patent and Trademark Office ("USPTO") should withdraw the provisional double patenting rejection and let this application issue. Accordingly, this rejection is overcome, and withdrawal thereof is respectfully requested.

In view of the amendment to the claims and the Remarks hereinabove, it is respectfully submitted that the present case is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark J. Cohen". The signature is fluid and cursive, with the first and last names being more prominent.

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